

Remarks

Claim rejections 35 USC § 101

Claims 1-23 stand rejected as being directed to non-statutory subject-matter. The rejection notes that the ordering server is recited only in the preamble of the claims and thus is not accorded patentable weight.

As an initial point, Applicant gratefully acknowledges the Examiner's recognition that claim 23 was not addressed in the last response due to a simple oversight, and claim 23 has now been amended in line with claim 1, which is also amended.

Entry of amendments

Independent claims 1 and 23 have been amended to recite the specific involvement of the ordering server in the method steps. Independent claims 1 and 23 now specifically involve a particular machine in the following respects:

- "a) maintaining in said ordering server, a current order record ..."; and
- "b) maintaining a prioritized listing of locations, accessible by said ordering server, including ..."

Entry of these amendments is requested on a number of grounds. Firstly, recitation of the ordering server in the claim body does not necessitate any further search as the ordering server already appeared in the preamble. Secondly, the amendment does not necessitate any new considerations, as the merits of the claims have been fully argued and considered by the Examiner, with the sole issue being that the ordering server was not accorded patentable weight due to its position in the preamble. Thirdly, the amendment places the claims in condition for allowance.

Arguments against rejection

Applicants submit the following three arguments, each of which independently justifies withdrawal of the rejection.

1. Rejection continues to be based only on “machine or transformation” test

In the Office Action, in the detailed rejection of claim 1 on pages 1 and 2, the rationale given is that “In order for a method to be considered a “process” under section 101, a claimed process **must** [emphasis added] either: (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing.” No other test or criteria are advanced in the rejection, and thus the Office Action indicates that the “machine or transformation” test is the sole or exclusive test for patent eligibility. As pointed out in Applicants’ last response, the Supreme Court has held, in Bielski v. Kappos, that this is not a valid approach to determining patent eligibility.

Nothing else in the Office Action supplements this reasoning. For example, in the section entitled “Response to Arguments”, the Examiner acknowledges that Applicants previously made two arguments, the second of which was that a rejection based solely on the “machine or transformation” test fails to properly address the enquiry set forth by the Supreme Court. However, in response to that argument, there is simply the statement: “The Examiner respectfully disagrees.”

It is not indicated why the Examiner disagrees. The Examiner’s rebuttal argument is directed (as regards claims 1-23) to pointing out that no patentable weight is accorded to the preamble, which is a rebuttal of the other argument, namely that the machine or transformation test was satisfied.

No other test or considerations are applied in the Office Action to the rejection of claims 1-23. No clarification is advanced suggesting that the Examiner has applied any other criteria. Furthermore, no reasons are presented as to why the machine or transformation test should continue to be used as the sole enquiry for patent eligibility, as is the case.

It is respectfully submitted therefore that the Examiner has not answered the substance of Applicants’ earlier traversal in accordance with MPEP 707.07(f). Accordingly, by

continuing to argue the rejection based solely on the "machine or transformation" test, and without answering the substance of Applicants' second argument, the action is not complete as required by 37 CFR 1.104 and should not have been made final. Withdrawal of finality is respectfully requested for this reason.

The *August 2010 Interim Bilski Guidance* provided examples of additional factors which should be considered other than the machine or transformation test. It does not appear that such factors have been considered. Without prejudice to Applicants' arguments (below) that the claims satisfy both the machine and the transformation branches of that test, the following additional indicators weigh in favor of a finding that the claims are patent eligible (quoting from the *101 Method Eligibility Quick Reference Sheet*):

- “The claim is more than a mere statement of a concept.
- o The claim describes a particular solution to a problem to be solved.
- o The claim implements a concept in some tangible way.
- o The performance of the steps is observable and verifiable.”

The problem to be solved is finding a more efficient method of allocating location-based orders to agents. A particular solution is presented in the claims, involving the current order record and prioritized listing of locations. The concept is tangible, and the performance of the steps is observable and verifiable.

Accordingly, the subject-matter is patent-eligible when considered in line with the *August 2010 Interim Bilski Guidance*, even if the Machine or Transformation test was *not* satisfied.

2. “Machine” branch of test satisfied

The involvement of a particular machine (i.e. the ordering server) in the method of claims 1 and 23 is more than merely nominal, insignificant or tangential. These elements do not merely specify a field of use and are involved in more than mere data gathering.

The claim requires the steps of maintaining, in said ordering server, a current order record, and of maintaining a prioritized listing of locations, accessible by said ordering server. This clearly indicates the ordering server is programmed to carry out the steps of the method, and thus it is not a general purpose computer. Referring again to the *August 2010 Interim Bilski Guidance*:

For computer implemented processes, the “machine” is often disclosed as a general purpose computer. In these cases, the general purpose computer may be sufficiently “particular” **when programmed to perform the process steps**. Such programming creates a new machine because a general purpose computer, in effect, becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software. **To qualify as a particular machine under the test, the claim must clearly convey that the computer is programmed to perform the steps of the method** because such programming, in effect, creates a special purpose computer limited to the use of the particularly claimed combination of elements (i.e., the programmed instructions) performing the particularly claimed combination of functions. [emphasis added]

It is respectfully submitted that amended claims 1 and 23 clearly convey that the computer is programmed to perform the steps of the method. Accordingly, patentable weight should be accorded to the machine features now recited in the claims.

It is further submitted that the following arguments, submitted as part of the last response, apply *a fortiori* to the amended claims, in demonstrating that the indicators set out in the *July 2010 Interim Guidance* are present:

1. *Express recitation of a machine* (i.e. the ordering server)
2. *Machine is particular* (see the argument above that a computer which is clearly stated in the claim to be programmed to carry out the method steps is a particular machine not a general machine)

3. *Machine implements the claimed steps* (see preceding point)
4. *The claim is more than a mere statement of a concept* (it sets out specific steps that must be taken, files that must be created and records that must be referred to).
5. *The claim describes a particular solution to a problem to be solved* (a particular method of allocating orders according to a defined series of steps and rules, operated by a programmed ordering server)
6. *The claim implements a concept in some tangible way* (i.e. it requires the creation and maintenance of various records in the ordering server, and the interaction of the ordering server with the outside world via specified inputs (requests) and outputs (allocating an order), in line with the method steps set forth in the claim)
7. *The performance of the steps is observable and verifiable* (the claim requires the creation and maintenance of e.g. a current order record identifying a first location and first time at which each agent is expected to become free to fulfill a new order. It can be readily and observably verified if a computer system has created and is maintaining such a record. The same is true for the prioritized listing of locations.)

3. "Transformation" branch of test satisfied

In addition to the above arguments, it is respectfully submitted that the invention also satisfies the "transformation" branch of the "machine or transformation" test which, while not conclusive, is held to be a useful indicator. There are two such transformations, involving two articles: (1) the ordering server, and (2) data representing agents and locations.

The ordering server is a machine or apparatus and is clearly an article. It is transformed from one state to another on each occasion that the current order record and the prioritized listing of locations are updated as required by the claims.

The data representing agents and locations are also “articles”. Referring to the *August 2009 Interim Instructions*, it is stated that “An article can also be electronic data that represents a physical object or substance. For the test, the data should be more than an abstract value. Data can be specifically identified by indicating what the data represents, the particular type or nature of the data, and/or how or from where the data was obtained.” The agents and the locations are clearly physical objects, and the data representing them are thus articles.

The question of whether there is a “transformation” of such data is addressed in the *August 2009 Interim Instructions* as follows: “transformation of electronic data has been found when the nature of the data has been changed such that it has a different function or is suitable for a different use.”

The data representing agents is transformed, i.e. made suitable for a different use, by maintaining a current order record which identifies the first location and time at which each agent is expected to become free. The data representing locations is similarly transformed, i.e. made suitable for a different use, by maintaining the prioritized listing of locations including both scheduled locations which an agent is currently due to visit and unscheduled locations which the agent is not currently due to visit, the locations are prioritized to rank both the scheduled and unscheduled locations for the agent according to availability of the agent to reach each location after the time at which the agent will become free (which is taken from the current order record), and the availability is calculated for each location irrespective of whether or not the agent is due to visit a particular location. Then, in the determining step, use is made of the prioritized listing to determine the agent to whom an order is to be allocated.

Such processing of data clearly represents a transformation in which simple information regarding agents, locations and scheduled orders is transformed to make it suitable to determine which agent is best placed to service a new order based on calculated times to reach even those locations which no agent was ever scheduled to visit.

In summary, claims 1 and 23 are submitted to be patent eligible according to the *August 2010 Interim Bilski Guidance* outside the confines of the machine or transformation test, as well as meeting the criteria of the machine branch of the test and furthermore meeting the criteria of the transformation branch of the test.

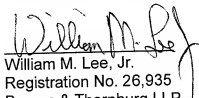
The above arguments in relation to claims 1-23 also apply to claims 2-22 which each incorporate the features of claim 1.

Claim 35 stands rejected as being directed to non-statutory subject-matter. It is believed that the amended wording of claim 35 is in compliance with the current practice of the USPTO, and therefore overcomes the rejection under 35 USC § 101.

In view of the amendments and arguments made herein, the applicants respectfully request the examiner withdraw the rejections, and allow the application.

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Respectfully submitted,


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